

REMARKS

I. Comments on the Restriction Requirement

Claim 6 (Group IV) is a method of making the polypeptides of Claim 1, and Claim 15 (Group VI) and Claim 16 (Group VII) are methods of using the polypeptides of Claim 1, which should be examined together with the polypeptides of Group I, per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products.

II. Comments on the Furness Declaration

The Examiner states on page 2 of the Final Office Action (under the heading Detailed Action) that "[t]he Furness Declaration filed **12/23/03** (paper no. 12) is also acknowledged." (emphasis added.) Applicants note that the Furness Declaration was filed on December 17, 2002 and received by the USPTO on **December 23, 2002**, according to the stamped Return Receipt Postcard (Courtesy Copy of Postcard enclosed).

III. Rejection of Claims 1-2 and 13-14 Under 35 U.S.C. § 101

The claimed polypeptides and compositions have utility as also explained in the Response filed December 17, 2002 (those comments being incorporated herein).

Furthermore, the rejection under 35 U.S.C. § 101 as made in the Final Office Action contains statements in at least six locations over three pages that appear to reference patent applications other than the instant application.

On page 5, the Examiner states that "[t]hus, the specification fails to support the asserted credible, specific and substantial utility of **human synthase** activity" and "[f]or example, the specification asserts that the claimed polypeptide has **fatty acid synthase** activity based solely on the structural similarity to other **FAS proteins**." (emphasis added.) On page 7, the Examiner states that "[a]lso no evidence has been brought forth that the claimed polypeptides are in fact

fatty acid synthase proteins.” (emphasis added.) Applicants note that the instant application does not recite “human synthase,” “fatty acid synthase,” or “FAS proteins.”

On page 6, the Examiner states that “Applicant presents the Furness Declaration as direct proof of the utility of the instant invention that ‘direct proof’ (referring to the Furness Declaration) of the utility of the claimed invention was submitted, **April 22, 2002** (paper no. 12).” (emphasis added.) Applicants note that the Furness Declaration was submitted in the instant application on December 17, 2002.

On page 6 of the Final Office Action, the Examiner states that “[t]he instant specification discloses that the claimed polypeptides are structurally related to **cell junction proteins**.” (emphasis added.) Applicants note that the instant application does not recite “cell junction proteins.”

On page 7 of the Final Office Action, the Examiner states that “[i]t is noted that the instant application was filed **March 16, 2000**.” (emphasis added.) Applicants note that the instant application was filed on April 24, 2001.

On page 7 of the Final Office Action, the Examiner states that “[t]he proposed uses of the claimed invention are simply starting points for further research and investigation into potential practical uses of the **claimed nucleic acids**.” (emphasis added.) Applicants note that the claims recite polypeptides and compositions.

Applicants assume that the cited statements in the Final Office Action were inadvertent.

IV. Rejection of Claims 1-2 and 13-14 Under 35 U.S.C. § 112, first paragraph, enablement

The Final Office Action does not repeat the rejection of Claims 1-2 and 13-14 under 35 U.S.C. § 112, first paragraph, on the basis of enablement, made in the Office Action mailed October 3, 2002. Applicants respectfully request clarification from the Examiner as to whether Claims 1-2 and 13-14 remain rejected under 35 U.S.C. § 112, first paragraph, on the basis of enablement.

In the event that Claims 1-2 and 13-14 remain rejected on the basis of enablement, Applicants submit that the claimed polypeptides and compositions are adequately enabled as also explained in the Response filed December 17, 2002 (those comments being incorporated herein).

V. Rejection of Claims 1, 21, and 33 Under 35 U.S.C. § 112, first paragraph, written description

On page 7 of the Final Office Action, the Examiner rejected Claims 1, 21, and 33 under 35 U.S.C. § 112, first paragraph, on the basis of written description. Applicants note that Claims 21 and 33 were canceled on the transmittal at the time of filing the instant application on April 24, 2001 (Courtesy Copy of transmittal enclosed). Furthermore, in the Office Action mailed October 3, 2002, Claims 1, 2, 13, and 14 were rejected on the basis of written description. Applicants respectfully request clarification from the Examiner as to whether Claims 2, 13, and 14 remain rejected under 35 U.S.C. § 112, first paragraph, on the basis of written description.

Applicants submit that the polypeptides of Claim 1 are adequately described as also explained in the Response filed December 17, 2002 (those comments being incorporated herein). In the event that Claims 2 and 13-14 remain rejected on the basis of written description, Applicants submit that the polypeptides and compositions of Claims 2 and 13-14 are adequately described as also explained in the Response filed December 17, 2002 (those comments being incorporated herein).

CONCLUSION

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance, and request that the Examiner withdraw the outstanding rejections. Early notice to that effect is earnestly solicited.

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact Applicants' Agent below.

If the USPTO determines that an additional fee is necessary, please charge any required fee to Deposit Account No. **09-0108**.

Respectfully submitted,
INCYTE CORPORATION

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Susan K. Sather

Susan K. Sather
Reg. No. 44,316
Direct Dial Telephone: (650) 845-4646

Customer No.: 27904
3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886